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2292 7590 02/12/2008 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER NICKERSON, JEFFREY L	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

## Office Action Summary

Application No.

10/522,749

Applicant(s)

SHIMIZU, JUNICHI

Examiner

JEFFREY NICKERSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This communication is in response to Application No. 10/522,749 filed nationally on 28 January 2005 and internationally on 16 February 2004. The amendment presented on 28 December 2007, which provides change to the abstract and claims 1, 4, 8, 9, and 10, is hereby acknowledged. Claims 1-17 have been examined.

#### ***Specification***

2. The amendment presented on 28 December 2007 that provides a replacement abstract is noted. The amendment includes the phrase "is provided" at the end of the first sentence, which falls under the category of implied phraseology and should be removed. The objection to the abstract is therefore maintained.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claim 1-17 have been considered but are either moot in view of the new ground(s) of rejection or not persuasive.

Regarding claims 1, 4, 8, 9, and 10, applicant argues that Yoneyama does not teach storing a plurality of emails but rather stores the keywords of the emails in the "storage

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portion" (Yoneyama: abstract and Figure 1). The examiner respectfully disagrees, as in order for Yoneyama's invention to retrieve and then display email messages it must inherently be storing the email messages (whether temporary or not), and Yoneyama further provides that these email messages are stored somewhere on the device. (Figure 2 in view of abstract)

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama (US 2003/0064707 A1), and further in view of Moody et al (US 2003/0167310 A1) and Andros, Jr. (US 4,817,194) and Chung (US 2002/0063738 A1).

Regarding claim 1, Yoneyama teaches wherein an e-mail viewing device (portable telephone) comprising:

a mail storage storing a plurality of emails (Yoneyama: abstract specifies messages are retrieved; Figure 2 and [0030] provide the emails are stored on the device)

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a display processor (display portion) displaying an e-mail stored in said mail storage onto a mail viewing screen; (Yoneyama: Figure 1, item 5; [0029] specifies retrieving email messages in order to display them)

an operation input unit (operation portion) for a user to enter a mail switching operation (clicking) for switching an email on the mail viewing screen; (Yoneyama: Figure 1, item 3; abstract specifies switching between messages by simply clicking)

a mail search portion (message search processing means) for an email stored in said mail storage on the basis of the email displayed on the mail viewing screen; (Yoneyama: Figure 1, item 2a; abstract specifies retrieving related email messages based off searching for the currently received message's keywords.)

when said operation unit accepts the mail switching operation first input after said email is displayed on said mail viewing screen, said mail search portion searches said plurality of emails, and arranges in time sequence each of said plurality of emails based on a transmission time of sent email or a reception time of received email,

said display processor displays the email extracted by said mail search portion on the basis of the mail switching operation of the user in time sequence (Yoneyama: abstract specifies switching between the received message and retrieved messages by clicking; Figure 6(j) depicts the retrieved emails are sorted by date/time)

said operation input unit includes a first operation input means (Yoneyama: Figure 6(k), button "Previous Message") for accepting a first mail switching operation and a second operation input means (Yoneyama: Figure 6(k), button "Next Message")

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for accepting a second mail switching operation, said first operation input means being different from said second operation input means (Yoneyama: [0048] and [0049]),

when said first operation input means accepts said first mail switching operation during display of said displayed email, said display processor displays another email sent before said displayed email or received before said displayed email, (Yoneyama: [0048] and [0049] specify "previous message" button can be used to retrieve preceding email while the current email is displayed. See also Figures 6(k) and 6(j))

when said second operation input means accepts said second mail switching operation during display of said displayed email, said display processor displays another email sent after said displayed email or received after said displayed email. (Yoneyama: [0048] and [0049] specify "next message" button can be used to retrieve following email while the current email is displayed. See also Figures 6(k) and 6(j))

Although Yoneyama teaches sorting displaying emails based on transmission/reception time he does not explicitly state that index data is generated to perform these tasks. Nor does Yoneyama teach triggering an input operation (either first or second) by continuously accepting an operation for a predetermined time. Nor does Yoneyama teach navigating and displaying the items in the list in a circular fashion.

Moody, in a similar field of endeavor, teaches wherein time index data is extracted and used to perform sorting and displaying of items in chronological order. (Moody: Figure 8E depicts parsing emails for date information and storing it; See also [0096] and [0097]; [0111] specifies they are later displayed chronologically)

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Andros, in a similar field of endeavor, teaches wherein an input operation (holding down a switch) can trigger the operation to activate after a predetermined period of time. (Andros: col 6, lines 1-20 specify holding down a switch for a certain amount of time will scroll to the next entry)

Chung, in a similar field of endeavor, teaches navigating and displaying items in a list in a circular fashion. (Chung: [0027] specify that when at the end of the list, items will roll over to the top if scrolling is continued in the direction of the end)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Moody for indexing the time information, the teachings of Andros for triggering an action based off a continuously depressed input operation for a predetermined period of time, and the teachings of Chung for navigating a list in a circular fashion. The teachings of Moody, Andros, and Chung, when implemented in the Yoneyama system, will allow one of ordinary skill in the art to efficiently sort and display emails in chronological order, allow users to activate navigational actions by depressing buttons for predetermined periods of time, and scroll through emails in a circular fashion. One of ordinary skill in the art would be motivated to utilize the teachings of Moody, Andros, and Chung in the Yoneyama system in order to enable a user to effectively browse their emails in an organized manner.

Regarding claim 2, the Yoneyama/Moody/Andros/Chung device teaches wherein

said mail search portion extracts an email whose sender or address matches the sender of an incoming mail displayed on the mail viewing screen. (Yoneyama: [0013])

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specifies the searching by keywords; [0034] specifies the keyword is a sender's name; [0039] specifies the sender's name is the sender of the currently received message)

Regarding claim 3, the Yoneyama/Moody/Andros/Chung device teaches wherein

said mail storage stores an outgoing mail and an incoming mail; (Yoneyama: [0005] specifies the use of outboxes and inboxes in the prior art; Yoneyama: [0034]-[0037] specify the use outboxes and inboxes for searching)

said mail search portion checks with the address of an outgoing mail or the sender of an incoming mail. (Yoneyama: [0040]-[0044] specify the selectively searching either the inbox, outbox, or both; [0034] specifies searching for a sender's name)

Regarding claim 4, this device claim comprises limitations substantially similar to those of claim 1 and the same rationale of rejection is used, where applicable. The Yoneyama/Moody/Andros/Chung device further teaches wherein

an email search portion searching for an email stored in said mail storage on the basis of the email designated by the user (Yoneyama: [0011] specifies that the searching is done based on the currently displayed message; [0015] specifies further that the searching is based off the currently displayed message and that the user has control over which message is displayed, thereby designating which message to use as a search basis)

Regarding claim 5, the Yoneyama/Moody/Andros/Chung device teaches wherein



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said mail storage stores an email together with transmission/reception time (date) of the email; (Yoneyama: Figure 5a and Figure 5b; Also Figure 4d all indicate emails are stored with date/time information)

said mail search portion extracts emails matching a search condition in time sequence of the transmission/reception times; (Yoneyama: [0040]-[0043] indicate a search based on inbox and outbox; Figure 6f and Figure 6h indicate that search results are returned sorted by date/time information)

and display processor sequentially switches and displays an email extracted by said mail search portion on the basis of a mail switching operation of the user.

(Yoneyama: [0060] specifies scrolling through the returned search messages by single clicking)

Regarding claim 6, the Yoneyama/Moody/Andros/Chung device teaches wherein

a movement direction on the time base is designated by the user as a mail switching operation on said operation input unit (Yoneyama: [0049] specifies that following messages are switched to by clicking 'Next' and that earlier messages are switched to by clicking 'Previous')

said mail search portion sequentially extracts emails matching the search condition in the movement direction on said time base (Yoneyama: [0049] specifies that the messages are switched to whether being earlier or following; Figures 6f and 6h indicate that the search results are sorted by date/time)

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said display processor sequentially switches and displays the emails extracted by said mail search portion each time the user performs a mail switching operation.

(Yoneyama: [0049] specifies that scrolling the list and sequentially opening retrieved emails is possible without closing the reference emails)

Regarding claim 7, the Yoneyama/Moody/Andros/Chung device teaches wherein

an email designated by the user is an email displayed on the mail viewing screen when the mail switching operation is performed for the first time. (Yoneyama: [0015] specifies that searching is based off the currently displayed and that search results are then turned into the currently displayed item, providing for searching based off a search result or after a switching has occurred)

6. Claims 8-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneyama (US 2003/0064707 A1), and in view of Lee et al (US 2002/0032743 A1), Roth et al (US 2004/0049388 A1), and Douglas et al (US 5,491,784).

Regarding claim 8, Yoneyama teaches an email editing device comprising:

a mail storage (storage portion) storing a plurality of reference mails;  
(Yoneyama: Figure 1, item 204; [0029] specifies that the storage portion stores key words, etc., and then the display portion retrieves past e-mail messages; Figure 2 and [0030] provides the emails are stored on the device)

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a display processor (display portion) displaying an e-mail stored in said mail storage onto a mail viewing screen; (Yoneyama: Figure 1, item 5; [0029] specifies retrieving email messages in order to display them)

a temporary storage (storage portion) storing data; (Yoneyama: Figure 1, item 204; [0029] specifies that the storage portion stores key words, etc.; Figure 2 and [0030] provides the emails are stored on the device)

a reference processor (control portion) copying an object in a reference mail to said temporary storage; (Yoneyama: [0053] specifies that you can copy from the reference email)

an editor pasting the object in said temporary storage into an email; (Yoneyama: [0053] specifies that you can paste information into an email)

an operation input unit (operation portion) for a user to enter a mail switching operation (clicking) for switching a reference mail on the mail reference screen; (Yoneyama: Figure 1, item 3; abstract specifies switching between retrieved messages by simply clicking; [0058] specifies it can be done by a single click without going back to the search results)

a mail search portion searching for the reference mail stored in said mail storage on the basis of the mail displayed on the mail screen (Yoneyama: Figure 1, item 2a; [0011] specifies retrieving related email messages based off searching on the basis of the currently displayed message)

said display processor displays the reference mail extracted by said mail search portion onto the mail reference screen on the basis of the mail switching operation of

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the user (Yoneyama: abstract specifies displaying retrieved emails based off the search onto the display screen, where the emails can be switched between based on clicking).

Yoneyama does not teach wherein one of the emails is an edition email (reply composition) nor does he teach wherein both the edition email and the reference email (incoming and stored emails) are simultaneously displayed on the screen. Nor does Yoneyama teach wherein the cursor is displayed in said mail edition screen on the basis of the switching operation. Nor does Yoneyama teach wherein the operation mode is automatically changed to copying when the focus of the cursor is moved to the reference window.

Lee, in a similar field of endeavor, teaches wherein a reply composition is displayed simultaneously with a reference email. (Lee: [0092]) He also teaches wherein the reference emails are incoming mails (Lee: [0027]).

Roth, in a similar field of endeavor, teaches wherein a cursor is displayed in the mail edition screen (new email message window) on the basis of the mail switching operation (user selecting to create a new email message). (Roth: [0421] specifies cursor automatically adjusting to the first editable region of the new email message window after the user selects to create a new email message)

Douglas, in a similar field of endeavor, teaches wherein the operation mode is automatically changed to copying when the focus of the cursor is moved to the reference window. (Douglas: col 7, lines 41-61 specify when the user's cursor is in the "shared address" window, the user need only click to copy an item back, with no other interaction; See also Figure 6)

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Lee for having a system capable of displaying both an edition and reference email simultaneously, Roth for automatically displaying a cursor, and Douglas for automatically changing to copy mode when changing to a reference window. The teachings of Lee, Roth, and Douglas, when implemented in the Yoneyama system, will enable one of ordinary skill in the art to compose email messages without the need to flip back to a reference email and enable easy use of features such as copying. One of ordinary skill in the art would be motivated to utilize the teachings of Lee in the Yoneyama system in order to reduce time loss of the user.

Regarding claim 9, this device claim comprises limitations substantially similar to those of claim 8 and the same rationale of rejection is used, where applicable. The Yoneyama/Lee/Roth/Douglas device further teaches wherein

a mail search portion searching for the reference mail stored in said mail storage on the basis of the reference mail designated by the user (Yoneyama: [0011] specifies that the searching is done based on the currently displayed message; [0015] specifies further that the searching is based off the currently displayed message and that the user has control over which message is displayed, thereby designating which message to use as a search basis)

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Regarding claim 10, the Yoneyama/Lee/Roth/Douglas device teaches an e-mail editing device comprising:

a mail storage storing data of each of a plurality of emails (Yoneyama: Figure 1, item 204; [0029] specifies that the storage portion stores key words, etc., and then the display portion retrieves past e-mail messages; Figure 2 and [0030] provide the emails are stored on the device);

an operation input unit for a user to enter an instruction regarding display of said plurality of emails (Yoneyama: Figure 1, item 3; abstract specifies switching between messages by simply clicking);

a mail search portion searching for an email stored in said mail storage on the basis of data of the email displayed according to said instruction (Yoneyama: Figure 1, item 2a; [0011] specifies that the searching is done based on the currently displayed message and its keywords);

a display processor generating edition screen data for displaying the contents of an edition mail (Lee: [0092] specifies a frame contains the reply email) whose data is rewritable (Lee: [0033] specifies the reply message can be altered) and reference screen data for displaying said searching email as a reference mail (Yoneyama: abstract specifies using email searches to find reference emails) whose data cannot be rewritten (Lee: [0033] specifies that the reference mail cannot be altered) on the basis of said data in response to an instruction given by the user (Lee: [0015] specifies the user clicking "reply" in order to activate the process);

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a display displaying a mail edition screen displaying the contents of said edition mail and a mail reference screen displaying the contents of said reference mail on the basis of said edition screen data and said reference screen data. (Lee: [0092] specifies simultaneously displaying the reply email and the reference email)

Regarding claim 11, the Yoneyama/Lee/Roth/Douglas device teaches an email editing device further comprising:

a temporary storage temporarily storing data; (Yoneyama: Figure 1, item 204; Yoneyama: [0029] specifies that the storage portion stores key words, etc.; Figure 2 and [0030] provide the emails are stored on the device)

a reference processor storing object data included in said reference mail to said temporary storage (Yoneyama: [0053] specifies that you can copy from the reference email, providing it is stored in the storage portion; Lee: [0033] specifies that ideally the reference email cannot be altered, providing that the copying would occur from the reference email, not the pasting);

an editor inserting object data stored in said temporary storage into said edition mail (Yoneyama: [0053] specifies that you can paste information into an email; Lee: [0033] specifies that ideally the reply email is alterable, providing the pasting would occur into the reply email).

Regarding claim 12, the Yoneyama/Lee/Roth/Douglas device teaches an email editing device wherein

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said mail search portion searches for an email stored in said mail storage on the basis of a reference mail (received/incoming or stored mail) displayed on said mail reference screen. (Lee: [0092] and abstract provide the reference email is an incoming email that is being replied to; Yoneyama: abstract specifies that the searching is done based off a received displayed email; Lee: [0092] specifies that the reference email has its own frame)

Regarding claim 13, the Yoneyama/Lee/Roth/Douglas device teaches an email editing device wherein

said mail search portion extracts an email whose sender or address matches the sender of said reference mail (Yoneyama: [0013] specifies the searching by keywords; Yoneyama: [0034] specifies the keyword is a sender's name; Yoneyama: [0039] specifies the sender's name is the sender of the currently received message).

Regarding claim 14, the Yoneyama/Lee/Roth/Douglas device teaches wherein

said mail search portion searches for an email stored in said mail storage on the basis of the reference mail designated by the user. (Yoneyama: [0011] specifies that the searching is done based on the currently displayed message; Yoneyama: [0015] specifies further that the searching is based off the currently displayed message and that the user has control over which message is displayed, thereby designating which message to use as a search basis)



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Regarding claim 15, the Yoneyama/Lee/Roth/Douglas device teaches wherein

said mail storage stores at least one of transmission time and reception time of said email (Yoneyama: Figure 6f and Figure 6h indicate that search results are returned sorted by date/time information, providing the information is stored)

said mail search portion sequentially extracts emails matching a search condition included in the reference mail designated by the user at said transmission time or said reception time (Yoneyama: [0049] specifies that the messages are switched to whether being earlier or following; Yoneyama: Figures 6f and 6h indicate that the search results are sorted by date/time; Lee: [0036] specifies that search criteria could include a period of time)

said display processor sequentially switches and displays said extracted emails on the basis of the mail switching operation of the user. (Yoneyama: [0049] specifies that the messages are switched to whether being earlier or following; Figures 6f and 6h indicate that the search results are sorted by date/time)

Regarding claim 16, this device claim comprises limitations substantially similar to those of claim 6 and the same rationale of rejection is used, where applicable.

Regarding claim 17, the Yoneyama/Lee/Roth/Douglas device teaches an email editing device further comprising:

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an input detector detecting an input of said mail switching operation (Yoneyama: Figure 1, item 3; Yoneyama: [0049] specifies that following messages are switched to by clicking 'Next' and that earlier messages are switched to by clicking 'Previous');

wherein an email designated by the user is a mail displayed on said mail viewing screen when said mail switching operation is input for the first time (Yoneyama: [0011] specifies that the searching is done based on the currently displayed message; Yoneyama: [0015] specifies further that the searching is based off the currently displayed message and that the user has control over which message is displayed, thereby designating which message to use as a search basis; Yoneyama: abstract specifies clicking to flip through messages).

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***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

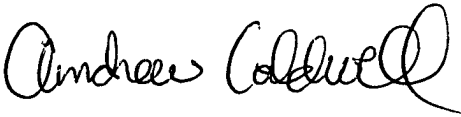
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY NICKERSON whose telephone number is (571)270-3631. The examiner can normally be reached on M-Th, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Caldwell Andrew can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J.N./  
Jeffrey Nickerson  
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